

rejection is traversed, and reconsideration and withdrawal thereof respectfully requested. The following is a comparison between the instant invention, as claimed, and the cited prior art.

An aspect of the invention, per claim 1, is an image-forming process involving a step of forming an electrostatic latent image on an electrostatic latent image carrier. The latent image is developed with an electrostatic image developer. The developed image is transferred to a transfer member. The transferred image is fixed and the developer remaining on the electrostatic latent image carrier after the transferring step is scraped with a cleaning blade. The electrostatic latent image carrier is constituted by an inorganic material and the developer contains at least toner particles and silicon carbide fine powder of 0.2 to 1.5 μm in average primary particle size, 10 to 50 m^2/g in specific surface area and 10 to 60% in amount of agglomerated particles. The silicon carbide fine powder is contained in an amount of 0.1 to 5.0% by weight based on the toner particles.

The Examiner asserted that Imai et al. teach an image forming process where the developer contains a toner and a fine powder of silicon carbide. The Examiner alleged that the silicon carbide has the same size, surface area, and amount used in similar toner additive applications for the same intended use as an abrasive material. In the alternative, the Examiner maintained that it would have been obvious that the silicon carbide would have the same agglomeration particle properties because of similar use and desired results of using silicon carbide external additives in electrophotographic developers.

Imai et al. do not anticipate or suggest the claimed image-forming process because Imai et al. is directed to applications using organic photoconductors and Imai does not disclose or suggest the electrostatic latent image carrier constituted by an inorganic material, as required by claim 1. In addition, Imai et al. do not disclose or suggest SiC powder containing 10% to

60% in amount of agglomerated particles, as required by claim 1. Furthermore, Imai et al. does not disclose or suggest the silicon carbide fine powder with the claimed particle size range and BET surface area. The BET surface area range and particle size range disclosed by Imai et al. is much larger than the claimed range.

Imai et al. do not disclose preparing SiC powder using an agglomerating agent. The amount of agglomerated particles in SiC powder prepared without agglomerating agent is less than 10%.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the disclosure in a single reference of each element of a claimed invention. *Helifix Ltd. v. Blok-Lok Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994); *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 399, 36 USPQ2d 1101 (Fed. Cir. 1995); *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). Because Imai et al. do not disclose an image forming process using an electrostatic latent image carrier constituted by an inorganic material and a developer containing silicon carbide particles in an amount of 10 to 60% agglomerated particles, and with the specific range of average primary particle size and specific surface area, as required by claim 1, Imai et al. do not anticipate claim 1.

Applicants further submit that Imai et al. do not suggest the claimed image-forming process because the claimed process provides unexpected results. When an electrostatic image developer containing SiC particles having less than 10% agglomerated particles is used toner

particles on the photoreceptor, cleaning failure, and formation of flaws on the photoreceptor results, as shown in Table 1(B) on page 49 of the specification.

Attached scanning electron microscope photographs (Exhibit A) show the difference between SiC powders with different levels of agglomerated particles. For example, Sample A depicts SiC powder with with 63.4% agglomerated particles, Sample B shows 43.4% agglomerated particles, and less than 10% agglomerated particles is illustrated by Sample C.

Filed concurrently with this response is a Declaration under 37 C.F.R. § 1.132 and an Experimental Report by one of the inventors, Yasushi Nakanishi, which further demonstrate the unexpected superiority of the claimed image-forming process, using SiC, as required by claim 1.

The data in Tables 1(A) and 1(B) of the specification and Table 3 of the Experimental Report of Yasushi Nakanishi clearly demonstrate that when SiC is used with less than 10% agglomerated particles, white spots are detected on the photoreceptor due to fusing of toner particles. In addition, the data show that when the amount of agglomerated particles is over 60% cleaning failure results. In contrast thereto, when the amount of agglomerated particles is within the claimed range of 10 to 60% a significantly greater number of copies can be produced while maintaining good imaging quality.

Applicants submit in light of the evidence of unexpected results obtained when using SiC as required by claim 1, the claimed process is not obvious in view of the cited references.

The dependent claims are allowable for at least the same reasons as claim 1, and further distinguish the claimed process. For example, claim 2 requires that the latent image carrier comprises amorphous silicon. Claim 3 further requires that the amorphous silicon is amorphous silicon containing 50% or more Si-O based on the chemical state of Si derived from the results of peak separation of the Si2p spectrum for the surface of the electrostatic latent image carrier in the

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X-ray photoelectron spectroanalysis. Claim 4 requires an arsenic-selenium series electrostatic latent image carrier of 60 to 150 μm in film thickness of vapor deposited film. Imai et al. do not suggest the claimed image-forming processing with these additional limitations.

In view of the above remarks, Applicants submit that this application should be allowed and the case passed to issue. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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